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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Wolfgang Bartsch

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06/27/2005

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EXAMINER

DUONG, FRANK

ART UNIT

PAPER NUMBER

2666

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Please find below and/or attached an Office communication concerning this application or proceeding.

✓

Office Action Summary	Application No. 09/832,416	Applicant(s) BARTSCH, WOLFGANG	
	Examiner Frank Duong	Art Unit 2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is a response to communications dated 02/04/05. Claims 1-5 are pending in the application.

Claim Objections

2. Claims 1-4 are objected to because of the following informalities:

As per **claim 1**:

Line 1 "protocols" 1 should change to --protocol- to comply with the written description.

Lines 4-5, the terms "may be" and "capable of" should be changed to "is" or "are", accordingly, for they fail to either recite positive limitation, suggest or make optional but does not require steps to be performed, limit a claim to a particular structure, or limit the scope of a claim or claim limitation.

As per **claim 2**, line 3, the term "may be" should be changed to "is" or "are", accordingly, for they fail to either recite positive limitation, suggest or make optional but does not require steps to be performed, limit a claim to a particular structure, or limit the scope of a claim or claim limitation.

As per **claim 3**, the terms "may be" should be changed to "is" or "are", accordingly, for they fail to either recite positive limitation, suggest or make optional but does not require steps to be performed, limit a claim to a particular structure, or limit the scope of a claim or claim limitation.

As per **claim 4**, lines 5-6, the terms “may be” and “capable of” should be changed to “is” or “are”, accordingly, for they fail to either recite positive limitation, suggest or make optional but does not require steps to be performed, limit a claim to a particular structure, or limit the scope of a claim or claim limitation.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Baker.

Regarding **claim 1**, in accordance with Baker reference entirety, Baker shows a decoding device for analyzing communication protocol (Fig. 1 and col. 15-53) comprising:

a generic decoder (Fig. 1; elements 16 and 20) into which a limited number of protocol descriptions may be loaded, the protocol descriptions being capable of being interpreted by the generic decoder (col. 5, lines 63-67); and

a specific decoder (Fig. 1; elements 16 and 22) designed for a certain protocol description, the generic and specific decoders being reversibly connected (col. 5, line 66 to col. 6, line 4) (note: at col. 2, lines 48-62, Baker discloses the invention is capable of being dynamically configured and modified and at col. 22, lines 39-40, Baker also

discloses the invention is to cover all modifications. Thus, it is inherent that the generic and specific decoders being reversibly connected).

Regarding **claim 2**, in addition to features recited in base claim 1 (see rationales discussed above), Baker further shows wherein the generic decoder comprises at least one element function (Fig. 2) that may be overlaid by a corresponding element function (Fig. 3) of the specific decoder (col. 2, lines 48-62 and thereafter, Baker discloses the use of common control logic and programmably configurable protocol description allows changes to existing protocols to be made and support for new protocols to be added without necessitating substantial system changes).

Regarding **claim 3**, in addition to features recited in base claim 2 (see rationales discussed above), Baker further shows wherein the one overlaid element function may be interpreted by the generic decoder (col. 2, lines 48-62 and thereafter, Baker discloses the use of common control logic and programmably configurable protocol description allows changes to existing protocols to be made and support for new protocols to be added without necessitating substantial system changes).

Regarding **claim 4**, in accordance with Baker reference entirety, Baker discloses a method of setting up a decoding device comprising the steps of:

provisioning a generic decoder (Fig. 1; elements 16 and 204 into which a limited number of protocol descriptions of communication protocols may be loaded, the protocol descriptions being capable of being interpreted by the generic decoder (col. 5, lines 63-67);

provisioning a specific decoder (Fig. 1; elements 16 and 22) for a certain protocol description (col. 5, line 66 to col. 6, line 4); and

reversibly connecting the generic and specific decoders to form the decoding device (note: at col. 2, lines 48-62, Baker discloses the invention is capable of being dynamically configured and modified and at col. 22, lines 39-40, Baker also discloses the invention is to cover all modifications. Thus, it is inherent that the generic and specific decoders being reversibly connected).

Regarding **claim 5**, in addition to features recited in base claim 4 (see rationales discussed above), Baker further discloses wherein the generic decoder comprises at least one element function (Fig. 2) overlaid by a corresponding element function (Fig. 3) of the specific decoder during connection of the generic decoding with the specific decoder (col. 2, lines 48-62 and thereafter, Baker discloses the use of common control logic and programmably configurable protocol description allows changes to existing protocols to be made and support for new protocols to be added without necessitating substantial system changes).

4. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Holzmann (USP 5,826,017).

Regarding **claim 1**, in accordance with Holzmann reference entirety, Baker shows a decoding device for analyzing communication protocol (Fig. 2 or 3 and col. 3, line 3 to col. 5, line 61 and thereafter) comprising:

a generic decoder (207) into which a limited number of protocol descriptions may be loaded, the protocol descriptions being capable of being interpreted by the generic decoder (col. 4, lines 54-60 and thereafter); and

a specific decoder (203 or 309) designed for a certain protocol description, the generic and specific decoders being reversibly connected (see Figs. 2-3) (col. 4, line 47-54 and thereafter).

Regarding **claim 2**, in addition to features recited in base claim 1 (see rationales discussed above), Holzmann further shows wherein the generic decoder comprises at least one element function (209 or 305) that may be overlaid by a corresponding element function of the specific decoder (col. 4, line 44 to col. 5, line 61).

Regarding **claim 3**, in addition to features recited in base claim 2 (see rationales discussed above), Holzmann further shows wherein the one overlaid element function 4205 or (203 and 31 13) may be interpreted by the generic decoder (col. 4, lines 56-60 and thereafter).

Regarding **claim 4**, in accordance with Holzmann reference entirety, Baker discloses a method of setting up a decoding device comprising the steps of:

provisioning a generic decoder (207) into which a limited number of protocol descriptions of communication protocols may be loaded, the protocol descriptions being capable of being interpreted by the generic decoder (col. 4, lines 54-60 and thereafter);

provisioning a specific decoder (203 or 309) for a certain protocol description (col. 4, lines 47-54 and thereafter); and

reversibly connecting the generic and specific decoders to form the decoding device (see Figs. 2-3).

Regarding **claim 5**, in addition to features recited in base claim 4 (see rationales discussed above), Holzmann further discloses wherein the generic decoder comprises at least one element function (209 or 305) overlaid by a corresponding element function of the specific decoder during connection of the generic decoding with the specific decoder (col. 4, line 44 to col. 5, line 61).

Response to Arguments

5. Applicant's arguments filed 02/04/05 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 02/04/05.

In the Remarks of the outstanding response, on page 3, pertaining the objection of "protocols", Applicants argue the term "protocols" are in the title and abstract of the instant applications, thus, comply with the written description.

Examiner respectfully disagrees and urges the Applicant to clearly point out where in the Details Description of the Invention, the "protocols" is disclosed in a response to this Office Action.

In the Remarks of the outstanding response, on page 3, pertaining the rejection under 35 U.S.C. § 102(b) of claim 1 as being anticipated by Baker et al (USP 5,793,954), Applicant argues "*There is no indication that the protocol description files of Baker represent "a limited number of protocol description", i.e., different protocols as*

opposed to configurable analysis according to a single protocol, as recited by Applicant in claim 1".

In response Examiner respectfully disagrees and asserts the interpretation of Baker against the claimed limitation is proper. There is no specific definition for "a limit number of protocol descriptions" in the claims or in the specification. As for the argument of "*different protocols as opposed to configurable analysis according to a single protocol*", a careful review of the claims Examiner finds no such language in the claims. Perhaps applicant refers to certain features that are disclosed in the present application but not recited in the reject claims in making the contention that the Baker reference fails to show certain feature of applicant's invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In the Remarks of the outstanding response, on pages 3-4, pertaining the rejection under 35 U.S.C. § 102(b) of claim 1 as being anticipated Holzmann (USP 5,826,017), Applicant argues "*There is no general decoder having a number of protocol descriptions in Holzmann, only a specific decoder that executes a specific protocol*".

In response Examiner respectfully disagrees and asserts the Holzmann, as clearly pointed out in the Office Action, does teach the claimed limitation in a manner as recited for the following rationales:

First, the disputed limitation calls for "a generic decoder ***into which a limited number of protocol descriptions may be loaded, the protocol descriptions being***

capable of being interpreted by the generic decoder” (emphasis added by Examiner). Given broadest interpretation, the disputed limitation calls for a “generic decoder” because the underlined terms does not recite positive limitation or make optional the subsequence clause after them. Holzmann discloses generic decoder 207.

Second, should the Applicant amend the disputed limitation to positively recited the subsequence clause after them, Holzmann, as clearly pointed out in the Office Action, still reads on the claimed limitation in a manner as recited. Let’s visit Holzmann. At col. 4, lines 54-60, Holzmann discloses “protocol execution device 207 executes the protocol by executing the protocol instructions in protocol description 203”. In other words, protocol instructions 205 being loaded into and executed (interpreted) by protocol execution device 207 corresponding to the claimed limitation.

Examiner believes an earnest attempt has been made in addressing all of Applicant’s arguments. Due to the response fails to place the application in a favorable condition for allowance and the arguments are not persuasive the rejection is maintained.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is 571-272-3164. The examiner can normally be reached on 7:00AM-3:30PM, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



FRANK DUONG
PRIMARY EXAMINER